APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,513	04/09/1999	PHILIP R. WISER	P-2090	8705

7590   06/17/2003

Steven J Rocci
Woodcock Washburn LLP
One Liberty Place
46th Floor
Philadelphia, PA   19103

EXAMINER
GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
3626	23

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/289,513	WISER ET AL.
	Examiner	Art Unit
	Luke Gilligan	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 March 2003</u> .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-49</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-49</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

Response to Appeal Brief

1.   In view of the Appeal Brief filed on 3/19/03, PROSECUTION IS HEREBY REOPENED.

New grounds of rejection are set forth below.

2.   To avoid abandonment of the application, appellant must exercise one of the following

two options:

      (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

      (2) request reinstatement of the appeal.

3.   If reinstatement of the appeal is requested, such request must be accompanied by a

supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132)

or other evidence are permitted. See 37 CFR 1.193(b)(2).

4.   It should also be noted that it was not the Examiner's intent to indicate claims 6-8 as

allowable in the Advisory Action mailed 12/17/02 in paper number 17. However, since the

Advisory Action provided no explanation of how the amended claims would be rejected, the

rejection is now provided herein.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6.   Claims 1-3, 10-26, and 39-49 are rejected under 35 U.S.C. 102(e) as being anticipated

by Payne et al., U.S. Patent No. 5,715,314.

7.   As per claim 1, Payne et al. teach a method for conducting electronic commerce through

a computer network, the method comprising: receiving, in a merchant computer system of the

computer network, a purchase request for a digital product (see column 5, lines 26-29, payment

computer of Payne et al. is read upon by the merchant system); receiving payment data in the

merchant computer system wherein the payment data specifies remuneration for the digital

product (see column 5, lines 29-34, this step is preformed by the payment computer of Payne et

al.); sending a request for reservation of the digital product to a content manager computer

system which can be different from the merchant computer system and which is coupled to the

merchant computer system through the computer network (see column 7, lines 31-33, merchant

computer of Payne et al. is read upon by the content manager, the request includes a request to

reserve access to the digital document for a specified duration of time; the two computers are

coupled via network 10 of Payne et al, see figure 1); receiving, in the content manager computer

system a delivery request signal from the merchant computer system wherein the delivery

request signal requests delivery of the digital product to a client computer system through the

computer network (see column 7, lines 31-39, the delivery request is sent from the payment

computer to the merchant computer via the buyer computer); sending transaction identification

data to the client computer system wherein the transaction identification data identifies the

digital product and represents remuneration in accordance with the payment data (see column

7, lines 18-24 and lines 31-32); receiving, in a delivery computer system of the computer

network, the transaction identification data from the client computer system (see column 7, lines

32-33); determining within the delivery computer system, in accordance with the transaction

identification data, the digital product (see column 7, lines 27-33); and sending, from the delivery

computer system, the digital product to the client computer system (see column 7, lines 46-50).

8.   As per claim 2, Payne et al. teach the method of claim 1 as described above, further comprising: sending, from the delivery computer system to the content manager computer system, a signal indicating that sending the digital product to the client computer system is completed (see column 3, lines 24-27).

9.   As per claim 3, Payne et al. teach the method of claim 2 as described above, further comprising: recording, by the content manager computer system, purchase data identifying the digital product and indicating that the digital product was purchased (see column 3, lines 24-27).

10.   As per claim 10, Payne et al. teach the method of claim 1 as described above, wherein requesting reservation by the merchant computer system comprises: encrypting data representing a requested reservation (see column 1, lines 59-64); sending the data as encrypted to the content manager computer system (see column 1, line 64 – column 2, line 2); and decrypting the data within the content manager computer system (see column 1, line 64 – column 2, line 2, the data has to be decrypted to be viewed).

11.   As per claim 11, Payne et al. teach the method of claim 1 as described above, wherein, in response to requesting reservation by the merchant computer system, the content manager computer system effects such a reservation of the digital product by: forming transaction data which include (i) the transaction identification data, (ii) product identification data which identifies the digital product, and (iii) binding data which binds the transaction to the client computer system (see column 5, lines 30-44); and sending the transaction data to the merchant computer system (see column 5, lines 48-53).

12.   As per claim 12, Payne et al. teach the method of claim 11 as described above, wherein sending the transaction identification data comprises encrypting the transaction identification data (see column 5, lines 42-47).

13.   As per claim 13, Payne et al. teach the method of claim 1 as described above, further

comprising: sending, from the merchant computer system, the payment data to a payment

authority (see column 1, lines 55-59); and receiving, in the merchant computer system from the

payment authority, payment authorization data (see column 1, lines 59-64).

14.   As per claim 14, Payne et al. teach the method of claim 13 as described above, further

comprising: sending the payment authorization data to the content manager computer system

(see column 2, lines 11-18).

15.   As per claim 15, Payne et al. teach the method of claim 14 as described above, wherein

sending the payment authorization data comprises: encrypting the payment authorization data

(see column 1, line 64 – column, line 2).

16.   As per claim 16, Payne et al. teach the method of claim 14 as described above, further

comprising recording, by the content manager computer system, that payment for the digital

product has been authorized (see column 2, lines 3-11).

17.   As per claim 17, Payne et al. teach the method of claim 16 as described above, further

comprising: receiving, in the merchant computer system from the content manager computer

system, acknowledgment data which indicates that payment for the digital product has been

recorded (see column 2, lines 11-18).

18.   As per claim 18, Payne et al. teach the method of claim 17 as described above, wherein

acknowledgement data includes the transaction identification data and a payment authorization

token which identifies payment authorization as recorded by the content manager computer

system (see column 2, lines 11-18).

19.   As per claim 19, Payne et al. teach the method of claim 18 as described above, wherein

the delivery request signal includes the transaction identification data and the delivery

authorization token (see column 6, lines 30-41).

20.   As per claim 20, Payne et al. teach the method of claim 19 as described above, wherein the delivery request signal is generated in response to selection of a URL by the user wherein the URL specifies the transaction identification data and the delivery authorization token (see column 6, lines 31-35).

21.   As per claim 21, Payne et al. teach the method of claim 17 as described above, wherein the acknowledgement data is encrypted (see column 1, line 64 – column 2, line 2).

22.   As per claim 22, Payne et al. teach the method of claim 1 as described above, wherein the delivery request signal is received in the content manager computer system from the client computer system (see column 4, lines 60-63); and further wherein the delivery request signal is generated by the client computer system in response to user-generated control signals (see column 4, lines 35-37).

23.   As per claim 23, Payne et al. teach the method of claim 22 as described above, wherein the user-generated control signals are incident to a graphical user interface of a web browser (see column 4, lines 43-45 and figure 5); and further wherein the user-generated control signals cause the client computer system to send the delivery request signal to the merchant computer system which in turn communicates the delivery request signal to the content manager computer system (see column 4, lines 60-63).

24.   As per claim 24, Payne et al. teach the method of claim 1 as described above, wherein the delivery request signal includes the transaction identification data (see column 5, lines 27-44).

25.   As per claim 25, Payne et al. teach the method of claim 24 as described above, wherein the delivery request signal is generated in response to selection of a URL by the user wherein the URL specifies the transaction identification data (see column 5, lines 27-30).

26.   As per claim 26, Payne et al. teach the method of claim 1 as described above, wherein

the transaction identification data, as received by the delivery computer system is certified as

originating from the client computer system (see column 5, line 42, particularly the "buyer

network address").

27.   As per claim 39, Payne et al. teach a method for conducting electronic commerce

through a computer network, the method comprising: receiving, in a merchant computer system

of the computer network, a purchase request for a digital product (see column 5, lines 26-29,

payment computer of Payne et al. is read upon by the merchant system); receiving payment

data in the merchant computer system wherein the payment data specifies remuneration for the

digital product (see column 5, lines 29-34, this step is preformed by the payment computer of

Payne et al.); sending a request for reservation of the digital product to a content manager

computer system which can be different from the merchant computer system and which is

coupled to the merchant computer system through the computer network (see column 7, lines

31-33, merchant computer of Payne et al. is read upon by the content manager, the request

includes a request to reserve access to the digital document for a specified duration of time; the

two computers are coupled via network 10 of Payne et al, see figure 1); receiving, from the

content manager computer system, voucher data which is readable by the content manager

computer system and which represents to the content manager computer system a transaction

in which the remuneration specified by the payment data is exchanged for the digital product

(see column 5, lines 48-56).

28.   As per claim 40, Payne et al. teach the method of claim 39 as described above, further

comprising: receiving, from the content manager computer system, inventory data which

specifies available digital products, including the digital product, and specified remuneration to

the content manager computer system for each of the available digital products (see column 4, lines 46-49).

29.   As per claim 41, Payne et al. teach the method of claim 40 as described above, wherein requesting reservation comprises: encrypting data representing a requested reservation (see column 1, lines 59-64); sending the data as encrypted to the content manager computer system (see column 1, line 64 – column 2, line 2); and decrypting the data within the content manager computer system (see column 1, line 64 – column 2, line 2, the data has to be decrypted to be viewed).

30.   As per claim 42, Payne et al. teach the method of claim 40 as described above, further comprising: sending, from the merchant computer system, the payment data to a payment authority (see column 1, lines 55-59); and receiving, in the merchant computer system from the payment authority, payment authorization data (see column 1, lines 59-64).

31.   As per claim 43, Payne et al. teach the method of claim 42 as described above, further comprising: sending the payment authorization data to the content manager computer system (see column 2, lines 11-18).

32.   As per claim 44, Payne et al. teach the method of claim 43 as described above, wherein sending the payment authorization data comprises: encrypting the payment authorization data (see column 1, line 64 – column, line 2).

33.   As per claim 45, Payne et al. teach the method of claim 44 as described above, further comprising: receiving, in the merchant computer system from the content manager computer system, acknowledgment data which indicates that payment for the digital product has been recorded (see column 2, lines 11-18).

34.   As per claim 46, Payne et al. teach the method of claim 45 as described above, wherein acknowledgement data includes the transaction identification data and a payment authorization

token which identifies payment authorization as recorded by the content manager computer

system (see column 2, lines 11-18).

35.   As per claim 47, Payne et al. teach the method of claim 46 as described above, wherein

the delivery request signal includes the transaction identification data and the delivery

authorization token (see column 6, lines 30-41).

36.   As per claim 48, Payne et al. teach the method of claim 47 as described above, wherein

the delivery request signal is generated in response to selection of a URL by the user wherein

the URL specifies the transaction identification data and the delivery authorization token (see

column 6, lines 31-35).

37.   As per claim 49, Payne et al. teach the method of claim 45 as described above, wherein

the acknowledgement data is encrypted (see column 1, line 64 – column 2, line 2).

Claim Rejections - 35 USC § 103

38.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

39.   Claims 4-9, and 27-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Payne et al., U.S. Patent No. 5,5715,314 in view of Stefik et al., U.S. Patent No. 6,236,971.

40.   As per claim 4, Payne et al. teach the method of claim 3 as described above. Payne et

al. do not explicitly teach apportioning compensation for sales of the digital product through a

media licensing computer system. Stefik et al. teach apportioning compensation for sales of the

digital product through a media licensing computer system (see column 4, lines 40-48). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to

combine the licensing capabilities of Stefik et al. with the electronic commerce environment of

Payne et al. One of ordinary skill in the art would have been motivated to include this element

for the purpose of provide a more diverse purchasing option to a prospective buyer.

41.   As per claim 5, Payne et al. in view of Stefik et al. teach the method of claim 4 as

described above, further comprising: aggregating purchase data from the content manager

computer system and other purchase data from one or more other content manager computer

system to form aggregated purchase data (see column 7, lines 55-59); and sending the

aggregated purchase data to a rights agent computer system such that the rights agent

computer system can apportion compensation for sales of the digital product (see column 7,

lines 59-65).

42.   As per claim 6, Payne et al. in view of Stefik et al. teach the method of claim 5 as

described above. Payne et al. do not explicitly teach encrypting the purchase data in such a

manner that data held secret by the media licensing computer system is required for decrypting

the purchase data. Stefik et al. teach encrypting data in such a manner that data held secret by

the media licensing computer system is required for decrypting the data (see column 26, lines

58-63). It would have been obvious to one of ordinary skill in the art at the time of the invention

to incorporate this encryption feature into the system of Payne et al. One of ordinary skill in the

art would have been motivated to make such a modification for the purpose of enhancing the

security of data communications within the system of Payne et al.

43.   As per claim 7, Payne et al. in view of Stefik et al. teach the method of claim 6 as

described above. Payne et al. do not explicitly teach encrypting the purchase data in such a

manner that modifications of the purchase data subsequent to the encrypting can be detected.

Stefik et al. teach encrypting data in such a manner that modifications of the data subsequent to

the encrypting can be detected (see column 12, lines 50-57). It would have been obvious to

one of ordinary skill in the art at the time of the invention to incorporate such a security measure

into the system of Payne et al. One of ordinary skill in the art would have been motivated to

incorporate such a feature for the purpose of enhancing security of stored data.

44.   As per claim 8, Payne et al. in view of Stefik et al. teach the method of claim 6 as

described above. Payne et al. do not explicitly teach encrypting the purchase data in such a

manner that removal of the purchase data from a sequence of purchase data records

subsequent to the encrypting can be detected. Stefik et al. teach encrypting data in such a

manner that removal of the data from a sequence of data records subsequent to the encrypting

can be detected (see column 12, lines 50-57). It would have been obvious to one of ordinary

skill in the art at the time of the invention to incorporate such a security measure into the system

of Payne et al. One of ordinary skill in the art would have been motivated to incorporate such a

feature for the purpose of enhancing security of stored data.

45.   As per claim 9, Payne et al. teach the method of claim 1 as described above. Payne et

al. do not explicitly teach encrypting the digital product before sending it to the client computer

system and then decrypting it once in the client computer system. Stefik et al. teach encrypting

the digital product before sending it to the client computer system and then decrypting it once in

the client computer system (see column 26, lines 39-52). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to combine the encrypting element of

Sefik et al. with the electronic commerce method of Payne et al. for the purpose of providing

increased security to users of the system.

46.   Claims 27-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et

al., U.S. Patent No. 5,715,314. Payne et al. teach the method of claim 26 as described above.

Payne et al. do not explicitly teach the specific types of digital products in claims 27-38.

However, these types of digital media were old and well known at the time the invention was

made. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include any of these types of digital media in the method of Payne et al. for the purpose of providing a more diverse selection to buyers.

Conclusion

47.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

48.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703)305-7687 for After Final communications.

49.   Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

CLG
June 13, 2003

DINH X. NGUYEN
PRIMARY EXAMINER